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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,277	02/02/2005	Igor Shvets	1817-0150PUS1	9349

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EXAMINER	
LAM, ANN Y	

ART UNIT	PAPER NUMBER
1641	

NOTIFICATION DATE	DELIVERY MODE
02/25/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No.	Applicant(s)	
	10/500,277	SHVETS ET AL.	
	Examiner	Art Unit	
	ANN Y. LAM	1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 November 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *47-89* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *47-89* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

It is noted that a previous restriction requirement (mailed October 11, 2007) had been made but was improper because it was made under 371 rules, which does not apply to this application. The restriction requirement of October 11, 2007 is hereby vacated and replaced by the following restriction requirement. (While Applicant had made an election based on the restriction requirement of October 11, 2007, such an election is moot as the restriction requirement upon which it is made has been vacated.)

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 47-55, drawn to a biochip assembly having releasable means for each port and well for reception of removable separate enclosed transfer conduits, classified in class 436, subclass 514.

II. Claim 56, drawn to a biochip assembly with two sets of reservoir wells, classified in class 435, subclass 287.4.

III. Claims 57-65, drawn to a biochip assembly, classified in class 422, subclass 63.

IV. Claims 66-78, drawn to a biochip assembly, classified in class 435, subclass 283.1.

V. Claims 79-89, drawn to a method of conducting a biological cell assay, classified in class 435, subclass 4.

The inventions are distinct, each from the other because of the following reasons:

Inventions (I-IV) and V are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process such as purification or synthesis.

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions the inventions are not disclosed as capable of use together and they have different designs, modes of operation and effects because invention I requires releasable connection means for each port and well for reception of removable separate enclosed transfer conduits, whereas invention II does not. Invention II requires two sets of at least two fluidly separate reservoir wells, one adjacent the inlet port and the other adjacent the outlet port of each biochip, wherein invention I does not.

Inventions I and III are unrelated. They are not disclosed as capable of use together and they have different designs, modes of operation and effects because invention I requires a liquid delivery unit having a *plurality* of liquid delivery port, one for connection to each biochip, whereas invention III does not require a plurality of liquid delivery port. Invention III requires a planar biochip sheet, an inlet port for each microchannel in the top face of the biochip sheet adjacent one end of the microchannel,

and an outlet port for each microchannel in the top face of the biochip sheet adjacent the other end of the microchannel, whereas invention I does not.

Inventions I and IV are unrelated. They are not disclosed as capable of use together and they have different designs, modes of operation and effects because invention I requires a liquid delivery unit having a *plurality* of liquid delivery port, one for connection to each biochip, whereas invention IV does not require a plurality of liquid delivery port. Invention IV requires a liquid delivery unit comprising a liquid outlet link assembly to provide a steady liquid delivery output rate below 10 ul per minute, whereas invention I does not.

Inventions II and III are unrelated. They are not disclosed as capable of use together and they have different designs, modes of operation and effects because invention II requires two sets of at least two fluidly separate reservoir wells, one adjacent the inlet port and the other adjacent the outlet port of each biochip, whereas invention III does not. Invention III requires a planar chip sheet, an inlet port for each microchannel in the top face of the biochip sheet adjacent one end of the microchannel, and an outlet port for each microchannel in the top face of the biochip sheet adjacent the other end of the microchannel, whereas invention II does not.

Inventions II and IV are unrelated. They are not disclosed as capable of use together and they have different designs, modes of operation and effects because invention II requires two sets of at least two fluidly separate reservoir wells, one adjacent the inlet port and the other adjacent the outlet port of each biochip, whereas invention IV does not. Invention IV requires a liquid delivery unit comprising a liquid

outlet link assembly to provide a steady liquid delivery output rate below 10 ul per minute, whereas invention I does not.

Inventions III and IV are unrelated. They are not disclosed as capable of use together and they have different designs, modes of operation and effects because Invention III requires a planar biochip sheet, an inlet port for each microchannel in the top face of the biochip sheet adjacent one end of the microchannel, and an outlet port for each microchannel in the top face of the biochip sheet adjacent the other end of the microchannel, whereas invention IV does not. Invention IV requires a liquid delivery unit comprising a liquid outlet link assembly to provide a steady liquid delivery output rate below 10 ul per minute, whereas invention III does not.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

(a) the inventions have acquired a separate status in the art in view of their different classification;

(b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;

(c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);

(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable

over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder**. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.Any inquiry

concerning this communication or earlier communications from the examiner should be directed to ANN Y. LAM whose telephone number is (571)272-0822. The examiner can normally be reached on Mon.-Fri. 10-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ann Y. Lam
Primary Patent Examiner